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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,071	02/09/2005	Hannes Floessholzer	AT 020051	4207

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
SEVERSON, RYAN J	
ART UNIT	**PAPER NUMBER**
3731	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/524,071	FLOESSHOLZER ET AL.	
	Examiner	Art Unit	
	Ryan Severson	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 February 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/23/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. EP 02102136.5, filed on 08/14/2002.

Information Disclosure Statement

2. The information disclosure statement filed 01/23/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
(e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
(f) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.
(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
(g) BRIEF SUMMARY OF THE INVENTION.
(h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(i) DETAILED DESCRIPTION OF THE INVENTION.
(j) CLAIM OR CLAIMS (commencing on a separate sheet).
(k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

3. The disclosure is objected to because of the following informalities: Referencing claims in the disclosure should be avoided. The disclosure should describe the structures and limitations of the claims, thereby without a description of the claims in the disclosure the claims can be broad and/or vague. Examples of improper use of claim referencing can be seen on specification pages 4 (lines 3, 18, 23, and 30) and 5 (lines 4, 8, 14, and 21). Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 1-3 and 5-9 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7 of copending Application No. 10/524,075. This

is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The information duplicated in claim 1 of the present application can be found in claims 1 and 4 of the conflicting application.

The information duplicated in claim 2 of the present application can be found in claim 5 of the conflicting application.

The information duplicated in claim 3 of the present application can be found in claim 7 of the conflicting application.

The information duplicated in claim 5 of the present application can be found in claim 6 of the conflicting application.

The information duplicated in claim 6 of the present application can be found in claim 1 of the conflicting application.

The information duplicated in claim 7 of the present application can be found in claim 1 of the conflicting application.

The information duplicated in claim 8 of the present application can be found in claim 2 of the conflicting application.

The information duplicated in claim 9 of the present application can be found in claim 3 of the conflicting application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Magnus et al. (2,423,245) in view of Bosland (3,802,309).** Magnus et al. reference discloses a device for extracting hairs using adhesive tape. The device comprises a "housing" (Figure 5, Ref. Numeral 1) designed to accommodate a "supply" (Ref. Numeral 2) of "depilating tape" (Ref. Numeral 7), an "application means" (Ref. Numerals 8 and 20) for applying the tape, and an "opening" in the housing to allow access to the skin for the tape. However, Magnus et al. reference does not disclose the use of a motor to drive the wind-up reel operated by a control button. Attention is drawn to Bosland reference, which teaches the use of a "motor" (Ref. Numeral 27) operated by a "control button" (Ref. Numeral 60) to drive a supply reel of tape in a tape dispenser for ease and efficiency of operation. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to replace the knob, which operates the wind-up reel of Magnus et al. reference, with the motor of Bosland reference for ease and efficiency of operation.

Regarding claim 1, the tape used in Magnus et al. reference can be varied (see Column 4, Lines 3-12) and therefore the wax depilatory tape of the instant application can be used in the Magnus et al. device. The "determination means" is interpreted to be the "control button" released to sever the electrical connection in the device, thereby stopping the movement of the tape. Since the motor turns the wind-up reel, which takes tape directly from the skin and off of the supply reel, an application length can be determined by the amount of time the "control button" is pressed. The longer the button is held, the more tape will be affixed to the skin of the patient and retracted.

Regarding claim 2, the "blocking means" is interpreted to be the brake of Bosland reference. When the button is pressed it is in the first position, which drives the motor causing tape to be removed from the supply reel, applied to the skin, and removed and taken-up by the wind-up reel. When the button is released (the second position), the brake engages the drive shaft and stops it from further motion, thereby not allowing any more tape to be removed from the supply reel.

Regarding claim 3, the "application means" (Ref. Numerals 8 and 20) of Magnus et al. reference can have application rollers (see Column 5, Lines 4-7) disposed at the distal ends thereof.

Regarding claim 4, the "cutting device" (Ref. Numeral 74) of Bosland reference could be placed at the end of the device of Magnus et al. reference in order to cut the tape after it has passed the application roller.

Regarding claim 5, the "blocking means" interacts with the supply reel by stopping rotation of the motor drive shaft, therefore stopping the removal of tape from the supply reel.

Regarding claim 6, the "wind-up reel" (Ref. Numeral 4) is designed to take up the depilating tape that was previously adhered to the skin.

Regarding claim 7, the "drive connection" of Bosland reference is the gear train (Figure 7, Ref. Numeral 28), which connects the drive shaft of the motor to the tape reel. In the Bosland reference, the motor is used to dispense or remove tape from the supply reel. Since Bosland reference discloses the motor is battery powered the motor is thereby powered by direct current. As is well known in the art, direct current motors are capable of being powered forward and backward. Therefore, the Bosland motor is capable of taking-up tape that has been previously adhered to the skin of a person. The action of the motor is used to extract the hair that is attached to the adhesive tape, thereby replacing the multiple steps of tensioning the hair with the knob and manually yanking the device away from the skin to extract hair and creating an easier and more efficient operation.

Regarding claim 8, the "means for interrupting the drive connection" of Bosland reference is interpreted to be completion or interruption of the electrical circuit by the "control button" (see Figure 3, Ref. Numeral 60).

Regarding claim 9, the "control button" of Bosland reference actuates the motor and the drive means by completing the electrical circuit, thereby providing power from the battery to the motor to turn the drive shaft, which in turn drives the "drive connection" or gear train, which then finally turns the wind-up reel to take-up the tape and extract hair.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: 5,219,237 to Zonneveld; 4,958,951 to Mann; and 5,803,636 to Legrain et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ryan Severson
October 30, 2006

ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
11/4/06.